

III. Remarks

Claims 1-10, 21, 22 and 30 are canceled. Claims 11-20 and 23-29 are pending.

Reference to CIP Application 10/843,257, now U.S. 7,148,160 B2

The present application is a parent application of continuation in part (CIP) application 10/843,257, now U.S. 7,148,160 B2. The present Examiner allowed the claims of the CIP application, after the claims were amended to recite polyurethane. Similarly, the claims of the present application are amended to recite a liquid impermeable film comprising polyurethane, and should be allowable, as were the claims of the CIP application.

The rejections in the Office Action mailed November 28, 2006 will now be discussed.

Rejection of Claim 11 Based on U.S. Patent 6,696,120 to Todt under 35 USC 102(e)

Claim 11 is rejected under 35 USC 102(e) as being anticipated by Todt. Claim 11 is amended to recite a liquid impermeable film comprising polyurethane. The present application is a parent application of continuation in part (CIP) application 10/843,257, now U.S. 7,148,160 B2. The present Examiner allowed the claims of the CIP application, after the claims were amended to recite polyurethane. Similarly, the claims of the present application are amended to recite a liquid impermeable film comprising polyurethane, and should be allowable, as were the claims of the CIP application.

The last two lines of Claim 11 describes a composite that is substantially moisture vapor permeable. Todt 6,690,120 does not state that a described heat shrinkable film 12 is water vapor permeable. Moreover, Todt's disclosure explicitly refers to the heat shrinkable film 12 as being described in an earlier patent U.S. 5,491,017 to Todt (same inventor) the description of which requires holes punched in the shrinkable film 12 to make it breathe. See, U.S. 5,491,017 at column 2, lines 4-7. Further, see col. 5 lines 13-15. Moreover, punching holes would not make the shrinkable film 12 substantially liquid

impermeable, as recited in Applicant's Claim 11. As a result, Claim 11 recites patentable differences over Todt to avoid the rejection under 35 USC 102(e).

Rejection of Claim 18 Based on U.S. Patent 6,696,120 to Todt under 35 USC 102(e) and 35 USC 103(a) based on similar materials disclosed by Todt.

Applicants Claim 18 (and parent Claim 11) recite a moisture vapor permeable composite, and should be allowable, as were the claims of the CIP application 10/843,257, now U.S. 7,148,160 B2. The present Examiner allowed the claims of the CIP application, after the claims were amended to recite polyurethane.

Claim 18 is rejected in view of Todt that discloses a heat shrinkable film 12. Todt does not disclose that the shrinkable film 12 is moisture vapor permeable, as recited in Applicant's Claim 18. However the rejection of Claim 18 states, that Claim 18 is being rejected for "the use of like materials" disclosed by Todt in the heat shrinkable film 12 of Todt. The rejection, in essence, requires Applicant's Claim 18 to recite a new material to be patentable.

The rejection is respectfully traversed. In essence, the rejection is rejecting Applicant's claimed moisture vapor composite (a "thing") on the basis of the materials used to make the composite. The rejection of a claimed "thing" based on the materials used to make the thing is not a proper rejection. Different things are not the same merely because they are made with the same materials. If different things require new materials to be patentable, no things would be patentable.

Moreover, Claim 18 describes a composite, which is a "thing" being claimed, and such a thing should be examined for patentability over prior art "things," and not rejected on the basis of materials used to make the claimed thing.

The rejection can not identify any "thing" that is moisture vapor permeable in the shrinkable film 12 of Todt, because Todt explicitly refers to the heat shrinkable film 12 as being described in an earlier patent U.S. 5,491,017 to Todt (same inventor) which requires holes to be punched in the shrinkable film 12 to make it breathe. See, U.S. 5,491,017 at column 2, lines 4-7, and further, see col. 5 lines 13-15. Moreover, punching holes would not make the shrinkable film 12 substantially liquid impermeable, as recited

in Applicant's Claim 11. The rejection of a claimed "thing" based on the materials used to make the thing is not a proper rejection.

Further, Applicant should not have the burden of proving that Applicant's composite is made from a new material or different material than a heat shrinkable film 12 of Todt, when Applicant's Claim 18 already describes a composite (thing) by reciting patentable differences from the shrinkable film 12 (thing) of Todt.

**Rejection of Claim 18 under 35 USC 102(e) and 35 USC 103(a) Based on
Inherency of Disclosure Missing From U.S. Patent 6,696,120 to Todt**

Claim 18 is rejected, as described at paragraph number 10, page 5, "Although Todt et al. [Todt ?] fail to explicitly teach the claimed water vapor permeability transmission, it is reasonable to presume that such property is inherent to the laminate of Todt. Support for said presumption is found in the use of like materials. ... The burden is on Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594."

MPEP 2112 IV. states, "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities."

MPEP 2112IV, as quoted above, explicitly prohibits probabilities or possibilities as a basis for supplying "missing descriptive matter...in the thing described in the reference."

The rejection of Claim 18 makes a presumption by stating, "it is reasonable to presume," [in essence, that the Todt shrink film 12 (thing) is moisture vapor permeable due to the material used to make the thing.] Similarly, the rejection presumes, in essence, that Applicant's claimed composite is moisture vapor permeable due to the material used to make the composite. However, such a presumption can not point to any part of the cited reference that would describe a moisture vapor permeable heat shrink film 12. Accordingly such a presumption is based on simply a probability or possibility that a moisture vapor permeable material is used to make the heat shrink film 12 of Todt.

MPEP 2112IV, as quoted above, explicitly prohibits probabilities or possibilities as a basis for supplying "missing descriptive matter...in the thing described in the reference."

Moreover, the disclosure in Todt itself dispels what the rejection states is "reasonable to presume" from Todt. Attention is directed to Todt, U.S. 6,696,120, at column 2, lines 6-14, disclosing a (thing) 10, a first layer 12 of a shrinkable stretchable film and a composite layer 14. Todt describes a thing 10, first layer 12 and composite layer 14, which amount to the use of like materials as well as a like thing 10 described in an earlier Todt (same inventor) patent U.S. 5,491,017, at column 2, line 14, et seq., (the thing 10 is used by Todt), "by arranging the material 10 around the article to be protected with the second layer 14 resting on the surface of the article and supporting the film or first layer 12 away from the surface of the article." Thus, Todt (same inventor) explicitly describes the use of like materials as well as like things in both Todt patents U.S. 6,696,120 and U.S. 5,491,017 even by using the same reference numerals and the same names of such things in both patents. Claim 18 is rejected for the use of like materials in Todt U.S. 6,696,120. The "like materials" referred to in the rejection citing Todt U.S. 6,696, 120 are moreover the like materials in Todt U.S. 5,491,017, since both patents describe the same reference numerals and the same names of things and the same materials making such things.

Moreover, Todt U.S. 5,491,017 recognizes that humidity is present within the envelope formed by the material 10. (Humidity refers to the presence of water vapor.) Todt U.S. 5,491,017 at column 4, lines 65-67 states, "Other chemical additives may be used to treat the fabric 14 such as chemicals to control the humidity within the envelope formed by the material 10." Todt would not require chemicals to control the humidity present in the envelope if the humidity was not present. If the envelope were vapor permeable the humidity would escape from the envelope, and would not be present in the envelope to require chemical control as stated by Todt.

Moreover, the only disclosure by Todt that refers to making the outer layer 12 breathe is by perforations, made by punching holes. See, U.S. 5,491,017 at column 2, lines 4-7, "The shrink material according to the present invention may, however, be made to "breathe" if desired by providing perforations in the outer shrink film." Moreover, U.S.

5,491,017 at column 5, lines 13-15, states, "Of course, the outer layer 12 can be made air permeable by punching holes in the material if such is desired."

Accordingly, Todt U.S. 5,491,017 provides for permeability in the outer layer 12 by punching holes in the same, which can not mean that the thing 12 is inherently permeable in either Todt U.S. 5,491,017 or Todt U.S. 6,696,120. Moreover, The punching of holes means that there can be no reasonable presumption that the material used to make the shrinkable film 12 is permeable. The shrink film 12 in Todt U.S. 6,696,120 is absent any disclosure of inherent permeability of the material used, for good reason, so as to avoid contradiction with the prior art of shrinkable film considered as a whole, to require holes punched to make the shrink film permeable. *In re Fitzgerald*, 205 USPQ 594 should not authorize the supply of missing disclosure that contradicts a good reason in the prior art for its absence.

In essence the rejection of Claim 18 is rejecting Applicant's claimed device on the basis of materials used to make the device, whereas such materials are capable of making different devices, and whereas the rejection has not established that the shrinkable film 12 (thing) of Todt is the same as Applicant's moisture vapor permeable device. Applicant should not have the burden of proving that Applicant's composite is made from a different material than a heat shrinkable film 12 of Todt, when Applicant's Claim 18 already describes patentable differences from the shrinkable film 12 (thing) of Todt.

Moreover, Todt's disclosure explicitly refers to the heat shrinkable film 12 as being described in an earlier patent U.S. 5,491,017 to Todt (same inventor) which requires holes to be punched in the shrinkable film 12 to make it breathe. See, U.S. 5,491,017 at column 2, lines 4-7. Further, see col. 5 lines 13-15. Thus, the presumption would not be fairly based, given that the Todt reference refers to an earlier Todt patent that contradicts the presumption.

Moreover, the Todt disclosure in U.S. 5,491,017 of shrinkable film 12 that requires punching holes is consistent with the scope of general knowledge that holes must be punched in heat shrinkable film. For example, it is within the scope of general knowledge that frozen foods in shrink film packages must have holes punched in the shrink film to allow escape of steam (water vapor) when subjected to heating in a

microwave oven. The directions on frozen food packages indicate the same. *In re Fitzgerald*, 205 USPQ 594 should not authorize a presumption that is contradictory of the general knowledge that shrinkable film requires holes to allow escape of water vapor.

Rejections Based on U.S. Patent 6,274,520 to Cordell under 35 USC 102(b)

Cordell discloses a high loft batting soaker 14 having soaker fibers needle punched into a scrim. See col. 1, line 45 *et seq.* The purpose is to absorb body fluids of an infant who is lying down on the soaker. Applicant's claim 11 is amended to recite, a moisture vapor permeable, substantially liquid impermeable composite for roofing, housewrap or protective clothing. Antecedent basis appears in paragraphs [0008] and [0019] of the specification. Roofing, housewrap and protective clothing have in common a need to be substantially liquid impermeable. A wet absorbing roofing, housewrap or protective clothing is undesirable. There is no motivation for one possessing ordinary skill in the art to suggest that absorbing fluid as in the soaker of Cordell would be suitable for roofing, housewrap or a protective garment in which absorbing fluid is undesirable. Thus, the soaker 14 of Cordell to absorb (body) fluid would not be suitable for suggesting Applicant's invention.

Claim 11 recites a patentable difference from Cordell, in which the high loft batting soaker 14 for absorbing fluid is bonded to a breathable film 16 of polyester or acrylic. Col. 1, line 52 *et seq.* Claim 11 is amended to recite a lightweight outer layer, which is bonded to a liquid impermeable film comprised of polyurethane.

Rejections Based on U.S. Patent 6,274,520 to Cordell under 35 USC 103(a)

Claim 18 is rejected, as described at paragraph number 11, page 6, "Although Cordell fail to explicitly teach the claimed water vapor permeability transmission, it is reasonable to presume that such property is inherent to the laminate of Cordell. Support for said presumption is found in the use of like materials. ... The burden is on Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594."

The present application is a parent application of continuation in part (CIP) application 10/843,257, now U.S. 7,148,160 B2. The present Examiner allowed the

claims of the CIP application, after the claims were amended to recite polyurethane. Similarly, the claims of the present application are amended to recite a liquid impermeable film comprising polyurethane, and should be allowable, as were the claims of the CIP application.

Cordell discloses a high loft batting soaker 14 for absorbing fluid is bonded to a breathable film 16 of polyester or acrylic. Col. 1, line 52 *et seq.* Claim 8, dependent from Claim 11, recites a patentable difference of materials from Cordell, wherein Claim 11 is amended to recite a lightweight outer layer, which is bonded to a liquid impermeable film comprised of polyurethane.

Applicant's Claim 11 (and dependent Claim 18) is amended to recite a lightweight layer bonded to said liquid impermeable film comprising polyurethane to distinguish from the high loft batting soaker 14 of Cordell next to layer 16. The high loft batting soaker 14 absorbs body fluids of an infant lying down on the soaker 14. Moreover, the soaker 14 is part of a waterproof sheet. The waterproof sheet would soak with the body fluids, the soaking of which blocks permeation of vapor throughout the sheet, which is unlike Applicant's composite that is moisture vapor permeable and has a lightweight outer layer next to a liquid impermeable layer comprising polyurethane. Roofing, housewrap and protective clothing have in common a need to be substantially liquid impermeable, and absorbing water is undesirable.

Rejection Based on U.S. Patent 6,274,520 to Cordell in view of Brunka US 5,733,824 under 35 USC 103(a)

The rejection states that it would be obvious to have used the PVC coating of Brunka in the fabric of Cordell motivated by a desire to create a fabric having increased water resistance. Cordell teaches a high loft batting soaker 14 of fibers punched into a scrim for absorbing an infant's body fluids (water). The high loft batting soaker 14 for absorbing fluid is bonded to a breathable film 16 of polyester or acrylic. Col. 1, line 52 *et seq.* There would be no motivation to create increased water resistance in the high loft batting soaker 14 of Cordell, because that would interfere with the purpose of the layer 14 for absorbing an infant's body fluids (water). Moreover, disclosure is missing in Cordell

and Brunka for a motivation to add the PVC coating of Brunka to Cordell's device. Missing disclosure in Cordell and Brunka can not be established by probabilities or possibilities, as prohibited by MPEP 2112 IV.

Applicant's Dependent Claims Are Independently Patentable

Applicant's dependent claims are independently patentable for reciting features of preferred embodiments of the invention, which features are independently patentable. Each of Claims 12 and 23 recites further features that describe the claimed fibers. Each of Claims 13 and 17 recites another or second outer layer. Each of Claims 14, 17 and 20 recites a nonwoven layer. Each of Claims 15, 19 and 26 recites an areal weight range. Claims 16 and 27 recite features of the mesh. Claim 18 recites a property of Applicant's claimed device. Each of Claims 24, 25, 28 and 29 recites the feature of a coating.

Conclusion

In view of the amendments and the Remarks supporting patentability, allowance of the application is requested.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account 04-1679.

Respectfully submitted,

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